

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES A. MAHOOD

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Appeal No. 1996-3799  
Application No. 08/252,511

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ON BRIEF

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Before JOHN D. SMITH, WALTZ, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 12, which are all of the claims pending in the subject application.

Claims 1 and 12 are illustrative of the claims on appeal and are reproduced below:

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1. A melt blend stabilizer composition exhibiting enhanced hydrolytic stability comprising:

(A) a phosphorous compound selected from the group consisting of phosphites and phosphonites, said phosphorous compound being present at a level of from 10 percent by weight to 90 percent by weight based on the total weight of the stabilizer composition,

(B) a hindered phenolic isocyanurate present at a level of from 10 percent by weight to 90 percent by weight based on the total weight of the composition, and

(C) less than about 10 percent by weight additional materials.

12. A method for making a stabilizer composition exhibiting enhanced hydrolytic stability, said method comprising:

(a) melt blending a phosphorous compound and a hindered phenolic isocyanurate; said composition comprising from 10 to 90 weight percent of said phosphorous compound and from 10 to 90 weight percent of said hindered phenolic isocyanurate based on the total weight of the composition.

The subject matter on appeal relates to a melt blend stabilizer composition comprising, in the recited amounts, (A) a phosphite or phosphonite, (B) a hindered phenolic isocyanurate, and (C) additional materials and to a method for making a stabilizer composition. According to the appellant, the claimed composition exhibits improved hydrolytic stability. (Substitute appeal brief, page 2.)

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The examiner relies upon the following prior art references as evidence of unpatentability:

Gilles 1977	4,025,486	May 24,
Chaser 1984	4,444,929	Apr. 24,
Neri et al. (Neri) 1990	4,957,956	Sep. 18,

Claims 1 through 12 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined teachings of Chaser, Gilles, and Neri. (Examiner's answer, pages 3-4.)<sup>1</sup>

Upon careful consideration of the entire record, we agree with the appellant (substitute appeal brief,<sup>2</sup> page 8) that the examiner has not established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. Accordingly, we reverse. The reasons for our determination follow.

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<sup>1</sup> The examiner has withdrawn the rejection of claims 1 through 12 under the first paragraph of 35 U.S.C. § 112. (Examiner's answer, page 3; final Office action, page 2.)

<sup>2</sup> It appears that the substitute appeal brief ("Corrected Brief on Appeal" filed April 2, 1999), which eliminated certain minor informalities in the original appeal brief (Paper 8), has not been recorded in the "Contents" section of the file wrapper. On return of this application, the examiner should ensure that the substitute appeal brief is assigned a paper number and is clerically entered.

Initially, we note that appealed claims 1 and 12 recite a "melt blend stabilizer composition" and "melt blending a phosphorous compound and a hindered phenolic isocyanurate," respectively. Although the specification does not expressly define the term "melt blend" or "melt blending," one skilled in the relevant art would understand from a reading of the entire specification that the term "melt blend" refers to the blending or mixing of the stabilizer components under conditions such that at least one of these components is in molten form. (Specification, page 2, lines 19-30; page 9, lines 20-26; page 10, lines 30-33.)

We now consider the teachings of the applied prior art references. Chaser describes stabilizer systems for organic materials in which sterically hindered 4-substituted-2,6-di-*t*-butylphenyl bis(substituted phenyl) phosphites are used in combination with hydroxyphenylalkylene isocyanurates. (Column 1, lines 32-39.) Although Chaser teaches that "the stabilizer mixture is added" to the organic material (column 5, lines 30-39), the only description relating to a "stabilizer mixture" is a solution or a suspension of the stabilizer compounds in a solvent, which is evaporated

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subsequent to mixing with the plastic (i.e., the organic material). (Column 7, lines 62-65.)

Similarly, Gilles teaches the combination of a hydroxyphenylalkyleneyl isocyanurate compound and a pentaerythritol phosphite compound as an ultraviolet light stabilizer for polyolefins. (Column 2, lines 15-18.) According to Gilles, the stabilizer can be dispersed in plastic materials by dissolving or suspending the stabilizer compounds in a solvent such as acetone or benzene, mixing the solution or suspension with the plastic in powder form, and then evaporating the solvent. (Column 5, lines 53-58.)

While the patentability of appealed claim 1 rests on the actual product made,<sup>3</sup> the examiner has not alleged that a stabilizer composition made by a process that does not involve melt blending (e.g., physical mixing) would form a product that is indistinguishable from the claimed product. Nor do we find any reasonable factual basis on this record for shifting the burden of proof to the appellant to show that the products are indeed distinguishable.

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<sup>3</sup> See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

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The examiner apparently realized that neither Chaser nor Gilles describes a "melt blend stabilizer composition" as required by appealed claim 1 or a method comprising "melt blending" a phosphorous compound and a hindered phenolic isocyanurate as required by appealed claim 12. To remedy this deficiency, the examiner relied upon Neri. Specifically, the examiner held as follows:

Since Neri et al. discloses that conventional combinations of hindered phenols and phosphorus compounds overcome their tendencies towards hydrolysis when utilized in solid continuous and dispersed particulate phases, formed by melt blending, and followed by rapid cooling, the incorporation of an additional step of melt blending the Gilles compositions to form a solid particulate blend for the purpose of discouraging premature hydrolysis, would have been an obvious variation to one of ordinary skill in the art at the time of applicant's invention. [Examiner's answer, p. 4.]

We disagree.

Neri teaches a stabilizing composition containing a continuous and amorphous phase of tetrakis-[3-(3,5-di-*t*-butyl-4-hydroxyphenyl)-propionyl-oxymethyl]methane and a dispersed phase of certain organic phosphites. (Column 2, lines 1-7.) Although Neri describes mixing the tetrakis-[3-(3,5-di-*tert*-butyl-4-hydroxyphenyl)-propionyl-oxymethyl]methane and the

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organic phosphite in molten form (column 3, line 41 to column 4, line 38), there is no teaching, motivation, or suggestion in the applied prior art to extend Neri's melt blending technique to a mixture of a phosphorous compound and a hindered phenolic isocyanurate as called for in the claims on appeal. As pointed out by the appellant (substitute appeal brief, page 8), "[b]oth the suggestion and reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure."

In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) (citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)). Here, neither the suggestion nor the expectation of success is found in the applied prior art.

For these reasons, we hold that the applied prior art references do not establish a prima facie case of obviousness against appealed independent claims 1 and 12 within the meaning of 35 U.S.C. § 103. Since appealed claims 2 through 11 all depend from claim 1, it follows that the subject matter of these dependent claims would also not have been obvious

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over the applied prior art references. In re Fine, 837 F.2d  
1071, 1076,  
5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

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